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REMARKS

This Response is submitted in response to the Office Action dated August 27, 2002. Claims 1 to 4, 7, 9, 10, 12, 13, 15, 17, 19 to 23, 25 to 32, 34 and 35 are pending in this application. Claims 1, 17, 31, 34, 35 and 36 have been amended. No new matter has been added.

A petition for a One-Month Extension of Time to respond to the Office Action is submitted herewith. A check in the amount of \$110.00 is submitted herewith to cover the cost of the one-month extension. Please charge deposit account No. 02-1818 for any additional payment deemed necessary.

Claims 1 to 4, 7, 9 and 10, 12 and 13, 15, 17, 19 to 23, 25 to 32 and 34 to 35 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,823,873 to Moody ("*Moody*"). As an initial note, Applicants wish to clarify for the record that while the finality of the previous Office Action has been removed, the Examiner has entered the amendments and claim cancellations made in response to the paper No. 10, the Final Office Action of May 30, 2002. In that Response, Applicants made amendments and presented arguments to specifically overcome the references used in the May 30, 2002, Office Action. Applicants assume at this point that the amendments and arguments were sufficient to place the claims in allowance with respect to the references cited in that Office Action. Accordingly, it is assumed that if Applicants overcome the rejection based on *Moody*, the claims listed above should each be in condition for formal allowance.

Generally, *Moody* fails to disclose, teach or suggest one of the main functions of the present invention, which appears in each independent claim, namely, to provide a dual evaluation of sets of symbols. * The dual evaluation of the present invention takes place once upon generating a first set of symbols, wherein the player is rewarded for each award winning symbol or symbol combination. Thereafter, at least some but not all of the symbols of the first set are changed or modified, wherein a second evaluation takes place and the player is rewarded again for each winning symbol or combination that appears in the second or modified set of symbols even if that winning symbol or symbol combination was in the first set. *Moody* simply does not disclose this game.

Moody discloses different embodiments which can be summarized as variations of known games of stud poker and draw poker. *Moody*, in one embodiment, discloses a stud poker game operating side by side with a draw poker game. This is not the same as providing a first set of symbols, paying the player for each of the winning combinations of the first set of symbols, modifying the first set to produce a second set of symbols and paying the player for each of the winning combinations in the second set.

In particular, Figs. 1 to 3 of *Moody* disclose a stud poker game indicated by line 20 operating along side a draw poker game indicated by line 40. In Figs. 1 to 3, *Moody* provides two sets of symbols, modifies one of the sets of symbols, and then evaluates the one set as modified and the other set as unmodified (i.e., one set as a draw poker game and the other set as a stud poker game, respectively). Even though symbols taken from the stud poker line 20 are employed in the draw poker line 40, *Moody* does not disclose the elements of the present invention. Figs. 1 to 3 of *Moody* do not disclose, teach or suggest paying the player for each winning symbol or winning symbol combination on the stud line 20, modifying the stud line 20, and then paying the player for each winning symbol or winning symbol combination in the new set of symbols generated along the modified line 20.

Figs. 4 to 16 in *Moody* illustrate the "Version II" or Super Poker games of *Moody*. Specifically, Figs. 4 to 16 illustrate games 2A to 2G. Each of these games is a draw poker type game, wherein the player is paid for a combination of symbols that appear after an initial set of symbols is modified to include a new set of symbols. Thus, the Version II embodiments 2A to 2G are even further removed from Applicants' claimed invention than are the initial embodiments disclosed in connection with Figs. 1 to 3 of *Moody*. Of course, in draw poker the player can choose to keep the initially dealt hand, in which case the game pays the player once for the symbols as unmodified. In this case, however, the game does not perform a second evaluation after the player decides to keep each of the initially dealt cards. Embodiments 2A to 2G of *Moody* do not therefore disclose, teach or suggest the claimed invention.

Versions 2I and 2J of *Moody* are not illustrated by the figures. Version 2I involves dealing three separate hands to the player face up. The player sees each card

dealt and determines in each hand which cards to hold and which to discard. After making the selection, the player hits a "deal" button and the game evaluates each row simultaneously. Here again, *Moody* does not disclose, teach or suggest dealing the player hands of cards, awarding the player for each winning combination appearing in the originally dealt hands, allowing the player to then keep or discard a number of cards in the hands, and then awarding the player again based on each winning combination appearing in the modified hands.

Version 2J involves dealing five rows of cards, wherein the center row is face up. Each of the horizontal five rows is played in draw poker fashion. Since five rows of five cards are dealt, five vertical hands are formed additionally. Wherever a column of cards is left unchanged, *Moody* contemplates evaluating same on a stud poker basis. In sum, horizontally dealt hands are evaluated on a draw poker basis while certain vertically disposed cards may be evaluated on a stud poker basis. This is simply another way to combine a stud poker game that is evaluated simultaneously with a draw poker game.

After the Version II games, *Moody* continues on and discloses combining concepts of *Moody* with CARIBBEAN STUD POKER®, LET IT RIDE® and Texas Hold 'Em. Each of these combinations, as above, involves playing multiple poker games at once. *Moody* then discloses a game that combines Twenty-one with stud poker. In this embodiment, cards that are dealt either to the dealer or the player for Twenty-one are evaluated afterward for a stud poker payout. For the same reasons discussed above, none of these embodiments disclose, teach or suggest the elements of the present invention.

Additionally, even though *Moody* does not disclose, teach or suggest the present invention, certain of the claims have been amended for further clarifying the claimed invention.

Turning now to the claims of the present invention, amended Claim 1 is directed to a method for operating a slot machine having a plurality of symbols. The method comprises the steps of: (i) maintaining a list of award yielding symbol combinations; (ii) randomly generating on a plurality of paylines a first set of the symbols from the plurality of symbols; (iii) providing an award for each award yielding symbol combination appearing in the first set on any of the paylines; (iv) selecting at least one but not all of

the symbols in the first set for individual replacement and replacing each selected symbol in the first set with one of the plurality of symbols to generate the second set of symbols; and (v) providing an award for each award yielding symbol combination appearing in the second set on any of the paylines regardless of whether the award yielding combination in the second set appears in the first set. The "on any of the paylines" language has been added to clarify that an award is provided to the player for each award yielding symbol combination appearing in each set on any of the paylines. *Moody* does not disclose, teach or suggest these steps.

Moody does not disclose, teach or suggest generating on a plurality of paylines a first set of symbols; awarding the player for each award yielding combination appearing in the first set on any of the paylines; replacing at least one but not all of the symbols in the first set with another symbol; and awarding the player for each award winning combinations appearing in the second set on any of the paylines even if they appeared in the first set. As discussed above, *Moody* provides the player with an opportunity to play multiple poker hands at once, either multiple draw poker hands or one or more draw poker hands in combination with stud poker. When the player in *Moody* plays a draw poker game, however, the game is played under the normal rules of draw poker, which include paying the player after, and only after, the player selects to keep all cards or discarding at least one card and obtaining a replacement card. Accordingly, amended Claim 1 and Claims 2 to 4, 7, 9, 10, 12, 13, 15, 25 and 26 that directly or indirectly depend from amended Claim 1 are patentably distinguished over *Moody* and in condition for allowance. Applicants, as stated in the previous Response of July 29, expressly maintain the right to seek broader patent protection on the subject matter of the present invention in a continuation application for each of the pending claims.

Claim 17 is directed a method for operating a gaming device that includes a plurality of symbols. The method includes the steps of: (i) maintaining in a controller of the gaming device, a list of award yielding symbol combinations; (ii) generating a set of symbols, wherein when one of the symbols in the set is a first wild symbol; (iii) providing an award for each award yielding symbol combination appearing in the set including any award yielding symbol combinations including the generated first wild symbol which functions as one of the other symbols to maximize the award yielding combination; (iv)

selecting at least once but not all of the symbols in the set except for the first wild symbol for replacement and individually replacing each selected symbol with a second wild symbol; and (v) providing an award for each award yielding combination appearing in the set including any award yielding symbol combinations including the first and second wild symbols which each function as one of the symbols to maximize the award. Claim 17 has been amended to clarify that an award is provided for any award yielding symbol combinations including the generated first wild symbol and any award yielding symbol combinations including the first and second wild symbols.

Moody does not disclose, teach or suggest the elements set forth in Claim 17. For each of the reasons discussed above, *Moody* does not disclose, teach or suggest the elements of Claim 17, namely, providing a set of symbols, awarding for each winning combinations in the first set of symbols, replacing at least one but not all of the symbols in the first set with other symbols and providing an award for each winning combinations generated in the second set upon replacing the symbols. Moreover, although *Moody* mentions wild symbols at certain places, *Moody* does not disclose, teach or suggest generating a first set of symbols with a wild symbol and providing an award to the player using the wild symbol to maximize the award, and thereafter replacing another symbol in the set which is not the wild symbol with a second wild symbol and performing the second award evaluation using all of the wild symbols.

Moody discloses a "jokers wild" or a "deuces wild" game having wild symbols; however, there is only one evaluation which is made, regardless of whether a wild symbol is generated. Accordingly, Applicant respectfully submits that amended Claim 17 and Claims 19 to 22 and 27 and 28 that depend therefrom are patentably distinguished over *Moody* and are in condition for allowance.

Claim 23 is directed to a method for operating a gaming device including a plurality of playing cards. The method includes the steps of: (i) maintaining in a controller a list of award yielding playing card combinations; (ii) generating a set of playing cards, wherein one of the playing cards is a wild card; (iii) providing an award for each award yielding playing card combination appearing in the set, wherein the wild card functions as one of the cards so as to maximize the award yielding combinations in the set; (iv) selecting at least one but not all of the cards in the set except for the wild

card for individual replacement and individually replacing each selected playing card with another wild card; and (v) providing an award for each award yielding playing card combination in the replacement set, wherein the wild cards function as one of the playing cards to maximize the award yielding combinations. For each of the above disclosed reasons, *Moody* does not disclose, teach or suggest the elements of Claim 23.

As discussed above, it is possible in *Moody*, as in certain other known types of draw poker games, to generate a wild card on the initial five card deal and then generate a second wild card that replaces one of the cards that the player discards. However, draw poker and the disclosure of *Moody* only include a single evaluation which is made after the discarded cards are replaced. *Moody* does not disclose, teach or suggest paying the player for each winning combinations caused by the wild card in the stud hand and then paying the player again once the player discards one or more cards and receives a second wild symbol, as in Claim 23. Applicants therefore respectfully submit that Claim 23 and Claims 29 and 30 that depend therefrom are each patentably distinguished over *Moody* and are in condition for allowance.

Amended Claim 31 is directed to a method for determining an award in a slot machine including a plurality of symbols and a plurality of award yielding combinations of the symbols. The method includes the steps of: (i) randomly generating on a plurality of paylines a first set of symbols; (ii) providing a player an award for each award yielding symbol combination appearing in the first set on any of the paylines; (iii) selecting at least one but not all of the symbols in the first set for individual replacement and individually replacing each of the selected symbols with one of the symbols; and (iv) providing an award for each award yielding combination appearing in the second set on any of the paylines regardless of whether an award was provided for such an award yielding combination in the first set. The language "on any of the paylines" has been added to Claim 31 for clarity of the claimed invention.

For each of the reasons discussed above, *Moody* does not disclose, teach or suggest the elements of Claim 31. As stated above, *Moody* does not disclose, teach or suggest a set of symbols, providing an award for each award yielding symbol

combination before and after modifying the set. Applicants therefore respectfully submit that Claim 31 is patentably distinguished over *Moody* and is in condition for allowance.

Claim 32 is directed to a method for operating a gaming device including a plurality of symbols and a plurality of award yielding combinations of the symbols. The method includes the steps of: (i) generating a set of symbols, wherein one of the symbols in the set is a first wild symbol; (ii) providing an award for each award yielding symbol combination appearing in the set, wherein the wild symbol functions as one of the symbols to maximize the award yielding symbols in the set; (iii) individually substituting a second wild symbol for at least one but not all of the symbols in the set except for the first wild symbol; and (iv) providing an award for each award yielding symbol combination appearing in the set, wherein each wild symbol functions to maximize the award.

For each of the reasons discussed above, *Moody* does not disclose, teach or suggest the elements of Claim 32. In particular, *Moody* does not disclose awarding the player for each of the winning combinations created before and after the modification of a set of symbols. Further, *Moody* does not disclose, teach or suggest such a game in the context of generating a first wild symbol in the initial deal and generating a second wild symbol after replacing at least one of the symbols in the first set. Applicants therefore respectfully submit that Claim 32 is patentably distinguished over *Moody* and is in condition for allowance.

Amended Claim 34 is directed to gaming devices that generate a set of symbols, wherein one of the symbols is a wild symbol, providing an award for each award winning symbol combination in the set on any of the paylines, replacing at least one non-wild symbol in the set with another wild symbol and providing an award for each award winning combination of symbols in the replaced set on any of the paylines. The language "on any of the paylines" has been added to Claim 34 for clarity of the claimed invention.

For each of the reasons discussed above, *Moody* does not disclose, teach or suggest the combination of elements of Claim 34. As stated before, *Moody* does not disclose a dual evaluation, wherein an award is evaluated based on a set of symbols as originally generated and then as modified, such that an award is provided for each and

every award winning combination. Applicants therefore respectfully submit that Claim 34 is patentably distinguished over *Moody* and is in condition for allowance.

Amended Claim 35 was amended to clarify that awards are provided for "award yielding" symbol combinations rather than for any symbol combination. "Award yielding" is previously stated in Claim 35, so no antecedent basis problems are produced by the amendment. The amendment eliminates the possibility that another element is added using "symbol combinations" (inferring all symbol combinations) rather than using the previously defined "award yielding symbol combinations." Applicants respectfully assert that eliminating the possibility of an additional element is broadening if anything and certainly non-narrowing. Additionally, Claim 35 has been amended for clarity between the first and second wild symbols and for clarifying that an award is provided for each award yielding symbol combination appearing in the set including the first wild symbol and then for each award yielding symbol combination appearing in the set including the first and second wild symbols. For each of the reasons discussed above, *Moody* does not disclose, teach or suggest the combination of elements of Claim 35. Applicants therefore respectfully submit that amended Claim 35 is patentably distinguished over *Moody* and is in condition for allowance.

Amended Claim 36 is directed to a gaming device including a processor, a display device and a memory device which maintains a plurality of playing cards and a plurality of award yielding playing card combinations. The processor communicates with the memory device and the display device to randomly generate and display a set of said playing cards, wherein one of said playing cards in said set is a wildcard, provide and display in the set an award for each award yielding playing card combination appearing in that set including the wildcard, individually changing the wildcard to one of the playing cards and display said change, and providing and displaying an award for each playing card combination appearing in the set, regardless of whether the processor previously provided an award for said playing card combination. As stated above, *Moody* does not include this dual evaluation of each winning combination, where multiple awards are provided for single combination. Thus, for each of the reasons discussed above, *Moody* does not disclose, teach or suggest the combination of


elements of amended Claim 36. Applicants therefore respectfully submit that amended Claim 36 is patentably distinguished over *Moody* and is in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the Applicants' attorney, Adam Masia, at (312) 807-4284 to discuss this Response.

Attached hereto is a marked-up version of the changes made to the specification and Claims by the current Response. The attached page is captioned "**Versions with Markings to Show Changes Made.**"

Respectfully submitted,

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In the Claims:

Claim 1 has been amended as follows:

1. (Three Times Amended) A method for operating a slot machine including a plurality of symbols, said method comprising the steps of:

- (a) maintaining a list of award-yielding symbol combinations of said plurality of symbols in a controller;
- (b) randomly generating on a plurality of paylines a first set of the symbols from the plurality of symbols;
- (c) providing an award for each award-yielding symbol combination appearing in said first set on any of the paylines;
- (d) selecting at least one but not all of the symbols in the first set for individual replacement and individually replacing each said selected symbol in the first set with one of the plurality of symbols to generate a second set of the symbols; and
- (e) providing an award for each award-yielding symbol combination appearing in said second set on any of the paylines regardless of whether said award yielding symbol combination in the second set appeared in the first set.

Claim 17 has been amended as follows:

17. (Three Times Amended) A method for operating a gaming device including a plurality of symbols, said method comprising the steps of:

- (a) maintaining in a controller of said gaming device a list of award yielding symbol combinations of said plurality of symbols;
- (b) generating a set of said symbols, wherein one of said symbols in said set is a first wild symbol;
- (c) providing an award for each award yielding symbol combination appearing in said set including any award yielding symbol combinations including the generated first wild symbol which functions as one of the other symbols to maximize the award yielding combinations;
- (d) selecting at least one but not all of the symbols in the set except for the first wild symbol in the set for individual replacement and individually replacing each said selected symbol with a second wild symbol; and
- (e) providing an award for each award yielding symbol combination appearing in said set, ~~including the~~ including any award yielding symbol combinations including the first and second wild symbols which replace other symbols and each function as one of the symbols to maximize the award yielding symbol combinations.

Claim 31 has been amended as follows:

31. (Three Times Amended) A method for determining an award in a slot machine including a plurality of symbols and a plurality of award yielding combinations of said symbols, said method comprising the steps of:

- (a) randomly generating on a plurality of paylines a first set of said symbols;
- (b) providing a player an award for each award yielding symbol combination appearing in said first set on any of said paylines;
- (c) selecting at least one but not all of the symbols in said first set for individual replacement and individually replacing each said selected symbol with one of the symbols; and
- (d) providing an award for each award yielding symbol combination appearing in said second set on any of said paylines including all award yielding symbol combinations in the second set regardless of whether an award was provided for such award yielding combinations in the first set.

Claim 34 has been amended as follows:

34. (Twice Amended) A slot machine comprising:

a plurality of reels and a plurality of paylines with the reels;
a plurality of symbols on said reels, said symbols including a wild symbol;
a plurality of symbol combinations that each yield an award if generated by said reels; and

a processor which controls said reels, wherein said processor: (i) causes the reels to generate a set of said symbols along the paylines; (ii) provides an award for each award yielding symbol combination in said set on any of the paylines, said wild symbol functions as at least one other non-wild symbol; (iii) substitutes another one of the non-wild symbols in said set with another wild symbol; and (iv) provides an award for each award yielding symbol combination in said set on any of the paylines, regardless of whether the combination includes a wild symbol, wherein each wild symbol functions as at least one other non-wild symbol.

Claim 35 has been amended as follows:

35. (Twice Amended) A gaming device comprising:

a processor;

a memory device which maintains a plurality of symbols and a plurality of award yielding symbol combinations, wherein the processor communicates with the memory device to:

generate a set of symbols, wherein one of said symbols is a first wild symbol;

provide an award for each award yielding symbol combination appearing in said set, wherein said first wild symbol functions as one of the symbols;

individually substitute ~~another~~ a second wild symbol for at least one but not all other non-wild symbols in said set; and

provide an award for each award yielding symbol combination appearing in said set, wherein each wild symbol ~~functions~~ including the first and second wild symbols function as one of the symbols.

Claim 36 has been amended as follows:

36. (Amended) The gaming device comprising:

a processor; ~~and~~

a display device;

a memory device which maintains a plurality of playing cards and a plurality of award yielding playing card combinations, wherein the processor communicates with the memory device and display device to:

randomly generate and display a set of said playing cards, wherein one of said playing cards in said set is a wildcard;

provide and display an award for each award yielding playing card combination appearing in said set including said wildcard;

individually change said wildcard to one of the playing cards in the set and display said change; and

provide and display an award for each playing card combination appearing in said changed set, regardless of whether the processor previously provided an award for said playing card combination ~~and wherein said wildcard functions as one of the playing cards.~~